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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,021	04/19/2004	Richard Devlin Schwarz	114129.121US3	2504
23483 7590 05/25/2007 WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			EXAMINER MERCHANT, SHAHID R	
			ART UNIT 3694	PAPER NUMBER
			NOTIFICATION DATE 05/25/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/827,021	<b>Applicant(s)</b> SCHWARZ ET AL.	
	<b>Examiner</b> Shahid R. Merchant	<b>Art Unit</b> 3694	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/1/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Examiner has given consideration to applicant's Provisional Application No. 60/463,543 filed on April 17, 2003 and 60/528,271 filed on December 9, 2003. For examining purposes of this application, the effective filing date will be April 17, 2003.

### ***Drawings***

2. New corrected drawing in compliance with 37 CFR 1.121(d) are required in this application. Figures 2, 5, 7-15, 17-23 and 27-37 contain improper shading and/ or handwritten text, which may affect clarity once reproduced. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

3. Claim 1 objected to because of the following informalities: the word "that" is repeated on line 6 of claim. Appropriate correction is required.

4. Claims 18 and 38 objected to because of the following informalities: the phrase "comprising presenting" is awkwardly worded. Appropriate correction is required.

5. Claim 22 objected to because of the following informalities: the word "that" is repeated on line 9 of claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 6, 11 and 31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not defined what a time domain aspect and a financial attribute aspect are in the specification.

8. Claim 7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not defined what a first interval and a second interval are in the specification.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 1 and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 1 recites the limitation "the values" in line 5. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 1 recites the limitation "the value" in line 9. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 22 recites the limitation "the values" in line 7. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 22 recites the limitation "the value" in line 12. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 22 recites the limitation "the values" in line 24. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 22 recites the limitation "the value" in line 26. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1-17 and 19-21 rejected under 35 U.S.C. 102(e) as being anticipated by Robinson, U.S. Patent No. 6,484,152 (see attached PTO-892, Ref. A).

19. As per claim 1, Robinson teaches a method of evaluating holdings of a portfolio, the method comprising: identifying the holdings that comprise the portfolio (see column 5, lines 46-57); obtaining financial information for each of the holdings (see column 3, lines 11-67 and column 4, lines 1-64); identifying financial metrics that are to be used in evaluating the holdings (see column 5, lines 38-45); determining the values of the financial metrics for each of the holdings (see column 6, lines 24-27); identifying a set of evaluation metrics that that are to be used in evaluating the holdings, wherein the evaluation metrics are comprised of the financial information and the financial metrics (see column 6, lines 29-41); determining for each holding the value of at least some of the evaluation metrics; ranking the holdings of the portfolio for each evaluation metric, wherein an evaluation metric ranking is based upon the holdings' values that have been

determined for that evaluation metric (see column 7, lines 9-45); assigning an evaluation metric positional score to each holding that has received an evaluation metric ranking, wherein each evaluation metric positional score is based upon a holding's ranking in an evaluation metric (see column 7, lines 9-64); and generating an overall score for each holding of the portfolio, wherein the overall score for a holding is based upon the evaluation metric positional scores that are assigned to that holding (see column 8, lines 24-32).

20. As per claim 2, Robinson teaches the method of claim 1 as described above. Robinson further teaches wherein the step of generating an overall score for a holding comprises determining an average of the evaluation metric positional scores that are assigned to that holding (see column 7, lines 29-45).

21. As per claim 3, Robinson teaches the method of claim 1 as described above. Robinson further teaches wherein the evaluation metric positional scores that are assigned to a holding are weighted differently and wherein the step of generating an overall score for a holding comprises determining a weighted average of the evaluation metric positional scores that are assigned to that holding (see column 7, lines 60-67 and column 8, lines 1-32).

22. As per claim 4, Robinson teaches the method of claim 1 as described above. Robinson further teaches comprising: ranking the holdings of the portfolio based upon

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the overall scores that were assigned to each holdings (see column 9, lines 40-67 and column 10, lines 1-12); and generating an overall positional score for each holding, wherein a holding's overall positional score is based upon that holding's overall score ranking (see column 9, lines 40-67 and column 10, lines 1-12).

23. As per claim 5, Robinson teaches the method of claim 4 as described above. Robinson further teaches comprising: establishing an overall positional score threshold; and identifying each holding that has an overall positional score that falls below the overall positional score threshold (see column 6, lines 29-41).

24. As per claim 6, Robinson teaches the method of claim 1 as described above. Robinson further teaches wherein each evaluation metric is characterized by a time domain aspect and a financial attribute aspect (see column 3, lines 45-67 and column 4, lines 1-35).

25. As per claim 7, Robinson teaches the method of claim 1 as described above. Robinson further teaches wherein at least some of the evaluation metrics evaluate a change in an evaluation metric that occurs from a first interval to a second interval (see column 4, lines 23-64).

26. As per claim 8, Robinson teaches the method of claim 1 as described above. Robinson further teaches comprising: identifying a group of evaluation metrics from the

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set of evaluation metrics (see column 8, lines 8-32); generating a group score for each holding of the portfolio, wherein the group score for a holding is based upon the evaluation metric positional scores that are assigned to that holding for the group of evaluation metrics that are identified (see column 8, lines 8-32).

27. As per claim 9, Robinson teaches the method of claim 8 as described above. Robinson further teaches wherein the step of generating a group score for a holding comprises determining an average of the evaluation metric positional scores that are assigned to that holding for the group of identified evaluation metrics (see column 7, lines 29-45 and column 8, lines 24-32).

28. As per claim 10, Robinson teaches the method of claim 8 as described above. Robinson further teaches wherein the evaluation metric positional scores that are assigned to a holding are weighted differently and wherein the step of generating a group score for a holding comprises determining a weighted average of the evaluation metric positional scores that are assigned to that holding for the group of identified evaluation metrics (see column 7, lines 60-67 and column 8, lines 1-32).

29. As per claim 11, Robinson teaches the method of claim 8 as described above. Robinson further teaches wherein each evaluation metric is characterized by a time domain aspect and a financial attribute aspect and wherein the group is identified based

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upon a time domain aspect, a financial attribute aspect or both (see column 3, lines 45-67 and column 4, lines 1-35).

30. As per claim 12, Robinson teaches the method of claim 8 as described above. Robinson further teaches comprising: ranking the holdings of the portfolio based upon the group scores that were assigned to each holdings (see column 9, lines 40-67 and column 10, lines 1-12); and generating a group positional score for each holding, wherein a holding's group positional score is based upon that holding's group score ranking (see column 9, lines 40-67 and column 10, lines 1-12).

31. As per claim 13, Robinson teaches the method of claim 1 as described above. Robinson further teaches comprising: establishing an evaluation metric positional score threshold (see column 6, lines 29-41); and identifying for each holding the evaluation metrics that are assigned a positional score that falls below the evaluation metric positional score threshold (see column 6, lines 29-41).

32. As per claim 14, Robinson teaches the method of claim 1 as described above. Robinson further teaches comprising: establishing an overall score threshold (see column 6, lines 29-41); and identifying each holding that has an overall score that falls below the overall score threshold (see column 6, lines 29-41).

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33. As per claim 15, Robinson teaches the method of claim 1 as described above.

Robinson further teaches wherein one financial metric is indicative of a holding's cumulative economic profit over a given period of time (see column 3, lines 45-67 and column 4, lines 1-5).

34. As per claim 16, Robinson teaches the method of claim 15 as described above.

Robinson further teaches wherein the cumulative economic profit financial metric accounts for any special charges that a holding may have taken during the given period of time (see column 3, lines 45-67 and column 4, lines 1-5).

35. As per claim 17, Robinson teaches the method of claim 15 as described above.

Robinson further teaches wherein the financial metrics include a series of financial metrics that when aggregated together are equal to a holding's total shareholders equity at a given point in time (see column 3, lines 45-67 and column 4, lines 1-5).

36. As per claim 19, Robinson teaches the method of claim 1 as described above.

Robinson further teaches wherein the financial metrics include a plurality of financial metrics that dissect a holding's total shareholders equity at a given point in time into an organic shareholders equity financial metric and an unearned shareholders equity financial metric (see column 3, lines 45-67 and column 4, lines 1-5).

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37. As per claim 20, Robinson teaches the method of claim 19 as described above. Robinson further teaches wherein the organic shareholders equity financial metric reflects all of the business activities of the holding less cumulative dividends declared over the holding's life less net capital raised from a sale or redemption of the holding's stock (see column 3, lines 45-67 and column 4, lines 1-5).

38. As per claim 21, Robinson teaches the method of claim 1 as described above. Robinson further teaches wherein one financial metric is capable of determining an amount of cash that a holding would have had available at an end of a time interval had the holding had no change in a level of total debt and had received no net cash from a sale or redemption of the holding's stock (see column 3, lines 45-67 and column 4, lines 1-5).

***Claim Rejections - 35 USC § 103***

39. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

40. Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, U.S. Patent No. 6,484,152 (see attached PTO-892, Ref. A) in view of Official Notice.

41. As per claim 18, Robinson teaches the method of claim 17 as described above. Robinson does not explicitly teach presenting a chart that displays at least one of the series of financial metrics for a holding in comparison to the holding's total shareholders equity.

Official Notice is taken that presenting a chart that displays at least one of the series of financial metrics for a holding in comparison to the holding's total shareholders equity is common and well known in the art to show information on a chart.

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Robinson and Official Notice to present a chart of information because it allows a person to review information in a easy to read and understand format.

42. Claims 22-37 and 39-41 rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, U.S. Patent No. 6,484,152 (see attached PTO-892, Ref. A) in view of article Can You Trust Mutual Fund Rankings? by John Markese (see attached PTO-892, Ref. U). Hereinafter Markese.

43. As per claim 22, Robinson teaches a method of evaluating a holding against holdings of a background portfolio, the method comprising: identifying the holdings that comprise the background portfolio (see column 5, lines 46-57); obtaining financial information for each of the background portfolio holdings (see column 3, lines 11-67 and column 4, lines 1-64); identifying financial metrics that are to be used in evaluating the

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holding and the background portfolio holdings (see column 5, lines 38-45); determining the values of the financial metrics for each of the background holdings (see column 6, lines 24-27); identifying a set of evaluation metrics that are to be used in evaluating the holding and the background portfolio holdings, wherein the evaluation metrics are comprised of the financial information and the financial metrics (see column 6, lines 29-41); determining for each of the background portfolio holdings the value of at least some of the evaluation metrics (see column 7, lines 9-45); ranking the background portfolio holdings for each evaluation metric, wherein an evaluation metric ranking is based upon the background portfolio holdings' values that have been determined for that evaluation metric (see column 7, lines 45-64); assigning an evaluation metric positional score to each background portfolio holding that has received an evaluation metric ranking, wherein each evaluation metric positional score is based upon a background portfolio holding's ranking in an evaluation metric (see column 7, lines 45-64); generating an overall score for each of the background portfolio holdings, wherein the overall score for a background portfolio holding is based upon the evaluation metric positional scores that are assigned to that background portfolio holding (see column 8, lines 24-32); determining the values of the financial metrics for the holding that is to be evaluated against the background portfolio holdings (see column 6, lines 24-27); determining for the holding that is to be evaluated the value of at least some of the evaluation metrics (see column 6, lines 29-41); and generating an overall score for that holding based upon the evaluation metric positional scores that are assigned to that holding (see column 8, lines 24-32). Robinson does not explicitly teach determining an evaluation

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metric positional score for each evaluation metric value that is determined for the holding that is to be evaluated, wherein an evaluation metric positional score for that holding is determined by comparing that holding's evaluation metric value against the evaluation metric values that were determined for the background portfolio holdings for that evaluation metric.

Markese teaches determining an evaluation metric positional score for each evaluation metric value that is determined for the holding that is to be evaluated, wherein an evaluation metric positional score for that holding is determined by comparing that holding's evaluation metric value against the evaluation metric values that were determined for the background portfolio holdings for that evaluation metric (see Ref. U).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Robinson and Markese to compare the holdings of two portfolios because it allows an investor to compare and choose a combination of stocks that provides maximum satisfaction based on investors requirements.

44. As per claim 23, Robinson and Markese teaches the method of claim 22 as described above. Robinson does not explicitly teach wherein an evaluation metric positional score of the holding that is to be evaluated is determined by comparing that holding's evaluation metric value for a particular evaluation metric against the next highest evaluation metric value that was determined for the background portfolio

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holdings and the next lowest evaluation metric value that was determined for the background portfolio holdings.

Markese teaches wherein an evaluation metric positional score of the holding that is to be evaluated is determined by comparing that holding's evaluation metric value for a particular evaluation metric against the next highest evaluation metric value that was determined for the background portfolio holdings and the next lowest evaluation metric value that was determined for the background portfolio holdings (see Ref. U).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Robinson and Markese to compare the holdings of two portfolios because it allows an investor to compare and choose a combination of stocks that provides maximum satisfaction based on investors requirements.

45. As per claim 24, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches wherein the step of generating an overall score for the holding that is being evaluated comprises determining an average of the evaluation metric positional scores that are assigned to that holding (see column 7, lines 29-45).

46. As per claim 25, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches wherein the evaluation metric positional scores that are assigned to a holding are weighted differently and wherein the step of

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generating an overall score for a holding comprises determining a weighted average of the evaluation metric positional scores that are assigned to that holding (see column 7, lines 60-67 and column 8, lines 1-32).

47. As per claim 26, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches comprising: ranking the holdings of the background portfolio and the holding that is to be evaluated based upon the overall scores that were assigned to each holdings (see column 9, lines 40-67 and column 10, lines 1-12); and generating an overall positional score for each holding, wherein a holding's overall positional score is based upon that holding's overall score ranking (see column 9, lines 40-67 and column 10, lines 1-12).

48. As per claim 27, Robinson teaches the method of claim 26 as described above. Robinson further teaches comprising: establishing an overall positional score threshold; and identifying whether the holding that is to be evaluated has an overall positional score that falls below the overall positional score threshold (see column 6, lines 29-41).

49. As per claim 28, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches comprising: identifying a group of evaluation metrics from the set of evaluation metrics; generating a group score for each holding of the background portfolio and the holding that is to be evaluated, wherein the group score for a holding is based upon the evaluation metric positional scores that are

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assigned to that holding for the group of evaluation metrics that are identified (see column 6, lines 29-41).

50. As per claim 29, Robinson teaches the method of claim 28 as described above. Robinson further teaches wherein the step of generating a group score for a holding comprises determining an average of the evaluation metric positional scores that are assigned to that holding for the group of identified evaluation metrics (see column 7, lines 29-45 and column 8, lines 24-32).

51. As per claim 30, Robinson teaches the method of claim 28 as described above. Robinson further teaches wherein the evaluation metric positional scores that are assigned to a holding are weighted differently and wherein the step of generating a group score for a holding comprises determining a weighted average of the evaluation metric positional scores that are assigned to that holding for the group of identified evaluation metrics (see column 7, lines 60-67 and column 8, lines 1-32).

52. As per claim 31, Robinson teaches the method of claim 28 as described above. Robinson further teaches wherein each evaluation metric is characterized by a time domain aspect and a financial attribute aspect and wherein the group is identified based upon a time domain aspect, a financial attribute aspect or both (see column 3, lines 45-67 and column 4, lines 1-35).

53. As per claim 32, Robinson teaches the method of claim 28 as described above. Robinson further teaches comprising: ranking the holdings of the background portfolio and the holding that is to be evaluated based upon the group scores that were assigned to each holdings; and generating a group positional score for each holding, wherein a holding's group positional score is based upon that holding's group score ranking (see column 9, lines 40-67 and column 10, lines 1-12).

54. As per claim 33, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches comprising: establishing an evaluation metric positional score threshold; and identifying whether the holding that is to be evaluated has an evaluation metric positional score that falls below the evaluation metric positional score threshold (see column 6, lines 29-41).

55. As per claim 34, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches comprising: establishing an overall score threshold; and identifying whether the holding that is to be evaluated has an overall score that falls below the overall score threshold (see column 6, lines 29-41).

56. As per claim 35, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches wherein one financial metric is indicative of a holding's cumulative economic profit over a given period of time (see column 3, lines 45-67 and column 4, lines 1-5).

57. As per claim 36, Robinson teaches the method of claim 35 as described above. Robinson further teaches wherein the cumulative economic profit financial metric accounts for any special charges that a holding may have taken during the given period of time (see column 3, lines 45-67 and column 4, lines 1-5).

58. As per claim 37, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches wherein the financial metrics include a series of financial metrics that when aggregated together are equal to a holding's total shareholders equity at a given point in time (see column 3, lines 45-67 and column 4, lines 1-5).

59. As per claim 39, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches wherein the financial metrics include a plurality of financial metrics that dissect a holding's total shareholders equity at a given point in time into an organic shareholders equity financial metric and an unearned shareholders equity financial metric (see column 3, lines 45-67 and column 4, lines 1-5).

60. As per claim 40, Robinson teaches the method of claim 39 as described above. Robinson further teaches wherein the organic shareholders equity financial metric reflects all of the business activities of the holding less cumulative dividends declared

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over the holding's life less net capital raised from a sale or redemption of the holding's stock (see column 3, lines 45-67 and column 4, lines 1-5).

61. As per claim 41, Robinson and Markese teaches the method of claim 22 as described above. Robinson further teaches wherein one financial metric is capable of determining an amount of cash that a holding would have had available at an end of a time interval had the holding had no change in a level of total debt and had received no net cash from a sale or redemption of the holding's stock (see column 3, lines 45-67 and column 4, lines 1-5).

62. Claim 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, U.S. Patent No. 6,484,152 (see attached PTO-892, Ref. A) in view of article Can You Trust Mutual Fund Rankings? by John Markese (see attached PTO-892, Ref. U) and further in view of Official Notice.

63. As per claim 38, Robinson teaches the method of claim 37 as described above. Robinson does not explicitly teach presenting a chart that displays at least one of the series of financial metrics for a holding in comparison to the holding's total shareholders equity.

Official Notice is taken that presenting a chart that displays at least one of the series of financial metrics for a holding in comparison to the holding's total shareholders equity is common and well known in the art to show information on a chart.

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Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Robinson and Official Notice to present a chart of information because it allows a person to review information in a easy to read and understand format.

***Conclusion***

The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The following prior art, which is made of record but not relied upon, is considered pertinent to applicant's disclosure.

See attached **PTO-892**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid R. Merchant whose telephone number is 571-270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammel can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

  
ELLA COLBERT  
PRIMARY EXAMINER